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Michael D. Ellis

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ROPES & GRAY LLP

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SHANG, ANNAN Q

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/974,666	Applicant(s) ELLIS, MICHAEL D.	
	Examiner ANNAN Q. SHANG	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-36, 38-75 and 77-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18-36, 38-75 and 77-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/20/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-16, 18-36, 38-56, 58-75 and 77-95 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular the limitation “...**examining, without receiving user input...**” does not have support in Applicant's written disclosure. Furthermore all negative limitations must be fully supported in a specification.

Response to Arguments

3. Applicant's arguments with respect to claims 1-16, 18-36, 38-56, 58-75 and 77-83 have been considered but are moot in view of the new ground(s) of rejection.

With respect to the rejection of the last office action, applicant discusses the prior art of records and the claimed invention, amends claims and argues that the prior art of record does not teach the amended claim limitations (See page 21+ of Applicant's Remarks).

In response, Examiner disagrees. Examiner notes applicant's arguments, however, as indicate above as to the 112 rejection, Shah Nazaroff still meets the claims limitations. Shah Nazaroff discloses a user interface (fig. 2.210) which coordinates the launching of the on-demand media system and upgrades, among other things (col. 3, lines 59-65). Shah-Nazaroff discloses a client/server systems, which allows for a variety of ways for a user to interact with system (Broadcast sources 'BS' 130/Server System 'SS' 140), using input devices, such as key pad or mouse (fig.5, col. 3, lines 50-58), transmits requests to SS-140, to receive on-demand programs, PPV programs and Internet data (non-on-demand) (figs.1-6, col.1, lines 14-33, lines 48-59, col.2, line 18-col.4, line 1+ and col.6, line 15-col.7, line 1+). Shah Nazaroff meets all the claims limitations: retrieving the non-on-demand media data from the non-on-demand media data source; displaying a first set of on-demand media data **(such as receiving listings information from the broadcast source(s), col. 4, lines 1-7)**; receiving user input, examining at the user equipment, the displayed first set of on-demand media data to identify a second set of on-demand media data that corresponds to the displayed first set of on demand media data necessary for retrieval (such as a listings information from the broadcast source(s) based on preference, col. 4, lines 1-7 and col.6, lines 1-40); automatically establishing **a client-server** connection between the interactive TV application system and the on-demand media data source; **automatically retrieving** the set of on-demand media data from the on-demand media data source (such as periodically retrieving program information from the video source based on user preference(s), col. 4, lines 1-7); **automatically caching** the media data in cache on the

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user TV equipment (such as storing the periodically updated listing data for the media available in a program database, fig. 2.20 and cols. 3 and 4, lines 59-67 and 1-7); displaying the on-demand media data from cache of the user TV equipment in response to a user indication to access at least the on-demand media data; and displaying the non-on-demand media data in response to a user indication to access at least the non-on-demand media (such as providing programming guide with non-on-demand media and on-demand media as in fig. 5, col. 6, lines 16-48, through a user interface such as fig. 2.210, col. 3, lines 50-67). Hence the amended/unamended claims do not overcome the prior arts of record. The 102(e) rejection and the various 103(a) rejection meets all the claim limitations as discussed below. **This office action is made final.**

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4-5, 7, 18-22, 24-25, 27, 38-42, 44-45, 47, 58-62, 64-65, 67 and 78- 83 are rejected under 35 U.S.C. 102(e) as being anticipated by **Shah-Nazaroff et al (6,157,377)**.

As to Claims 1, 21, 41, and 61, **Shah-Nazaroff** discloses a method, computer readable medium, and system for retrieving data for use in an interactive television application system having an interactive TV application implemented at least partially on user TV equipment in which non-on-demand media data is provided by a non-on-demand media data source (such as pay-per-view listings from a cable satellite source, fig. 5) and on-demand media data is provided by an on-demand media data source (such as on-demand video listings from a satellite source or video game listings from an Internet source, fig. 5), and where the non-on-demand and on-demand media data sources are separate, comprising:

A communications device for communicating with the on-demand media data source (such as a digital satellite or internet connection) and non-on-demand media data source (such as a cable system) (fig. 2.230 and col. 4, lines 10-13); a cache memory (fig. 2.220 and cols. 3 and 4, lines 60-67 and 1-7); a display device (fig. 2.210 and col. 3, lines 50-54); a user input device (fig. 2.210 and col. 3, lines 54-57); and control circuitry (such as that comprising the media system, fig. 1.110) programmed to:

retrieving the non-on-demand media data from the non-on-demand media data source; displaying a first set of on-demand media data (**such as receiving listings information from the broadcast source(s), col. 4, lines 1-7**); receiving user input, examining at the user equipment, the displayed first set of on-demand media data to identify a second set of on-demand media data that corresponds to the displayed first set of on demand media data necessary for retrieval (such as a listings information from the broadcast source(s) based on preference, col. 4, lines 1-7 and col.6, lines 1-40);

automatically establishing **a client-server** connection between the interactive TV application system and the on-demand media data source; **automatically retrieving** the set of on-demand media data from the on-demand media data source (such as periodically retrieving program information from the video source based on user preference(s), col. 4, lines 1-7); **automatically caching** the media data in cache on the user TV equipment (such as storing the periodically updated listing data for the media available in a program database, fig. 2.20 and cols. 3 and 4, lines 59-67 and 1-7);

displaying the on-demand media data from cache of the user TV equipment in response to a user indication to access at least the on-demand media data; and displaying the non-on-demand media data in response to a user indication to access at least the non-on-demand media (such as providing programming guide with non-on-demand media and on-demand media as in fig. 5, col. 6, lines 16-48, through a user interface such as fig. 2.210, col. 3, lines 50-67).

As to Claims 2, 22, 42, and 62, Shah-Nazaroff discloses that the non-on-demand media data retrieved is television program listings data (such as pay-per-view listings, fig. 5).

As regards Claims 4, 24, 44, and 64, Shah-Nazaroff discloses that the on-demand media data retrieved is interactive television application software data (such as Mech Warrior 6000, fig. 5).

As regards Claims 5, 25, 45, and 65, Shah-Nazaroff discloses that the on-demand media data retrieved is video-on-demand listings data (such as for an on-demand movie "Titanic," fig. 5).

As regards Claims 7, 27, 47, and 67, Shah-Nazaroff discloses that the on-demand media data retrieved is interactive video games listings data (such as Mech Warrior 6000, fig. 5).

As regards Claims 18, 38, 58, and 78, Shah-Nazaroff discloses that retrieving on-demand media data from multiple on-demand media data sources (such as Satellite and the Internet, fig. 5).

As regards Claim 19, 39, 59, and 79, Shah-Nazaroff discloses caching on-demand media data from multiple on-demand media data sources (such as storing program data from a variety of on-demand media sources like Satellite and the Internet in a program database, fig. 2.220, cols. 3 and 4, lines 59-67 and 1-7).

As regards Claim 20, 40, and 60 Shah-Nazaroff discloses displaying non-on-demand media data and on-demand media data concurrently (fig. 5).

Claims 80-83 are met as previously discussed with respect to claim 1, 21, 41 and 61 above.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 23, 43, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Hofmann (5,883,677)**.

As regards Claims 3, 23, 43, and 63 Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose that the on-demand media data retrieved is genre data.

Hofmann discloses that the on- demand media data retrieved is genre data (figs. 5 and 6 and col. 8, lines 32-41, or such as labeling a program as a comedy, figs. 9A and 9B).

At the time of the invention it would have been obvious to one skilled in the art to include the genre data, as done in Hoffman, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user additional helpful information about his viewing choices.

8. Claims 6, 26, 46, and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Mathews, III (US 5,815,145)**.

As regards Claims 6, 26, 46, and 66 Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose that the on-demand media data retrieved is audio-on-demand listings data.

Mathews discloses that the on-demand media data retrieved is audio-on-demand listings data (col. 9, lines 40-49).

At the time of invention, it would have been obvious to one skilled in the art to add the audio-on-demand listings of Mathews, an analogous art, to the non-on-demand

and on-demand audio-video delivery of Shah-Nazaroff to give the user more on-demand media options.

9. Claims 8-9, 13, 28-29, 33, 48-49, 53, 68-69, and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Banker (US 5,485,221)**.

As regards Claims 8, 28, 48, and 68, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61, but fails to disclose that the on-demand media data retrieved is weather data.

Banker discloses that the on-demand media data retrieved is weather data (col. 6, lines 37-43).

At the time of invention, it would have been obvious to one skilled in the art to add the weather data of Banker, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more information options.

As regards Claims 9, 29, 49, and 69, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose that the on-demand media data retrieved is sports statistics data.

Banker discloses that the on-demand media data retrieved is sports statistics data (such as scores, col. 6, lines 37-43).

At the time of invention, it would have been obvious to one skilled in the art to add the sports statistics data of Banker, an analogous art, to the non-on-demand and on-

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demand audio-video delivery of Shah-Nazaroff to give the user more information options.

As regards Claims 13, 33, 53, and 73 Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21,41, and 61 but fails to disclose retrieving on-demand media data from the on-demand media data source in response to a user selection of an on-demand media listing.

Banker discloses retrieving on- demand media data from the on-demand media data source in response to a user selection of an on-demand media listing (such as by navigating the IPG menu options fig. 5A to reach sports information fig. 5C.550).

At the time of invention, it would have been obvious to one skilled in the art to add the additional retrieval of Banker, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user a structured, easy-to-use way of accessing additional data.

10. Claims 10, 30, 50, and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Lett (US 5,771,064)**.

As regards Claims 10, 30, 50, and 70, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21,41, and 61 but fails to disclose that the on-demand media data retrieved is stock market data:

Lett discloses that the on-demand media data retrieved is stock market data (col. 6, lines 37-43).

At the time of invention, it would have been obvious to one skilled in the art to

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add the stock market data of Lett, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more information options.

11. Claims 11-12, 31-32, 51-52, and 71-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Lewis (US 2003/0040962)**.

As regards Claims 11, 31, 51, and 71, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose providing metadata contemporaneously with non-on-demand media data.

Lewis discloses providing metadata (such as embedded control data that allows a user to edit or remove certain sections of the media) contemporaneously (such as by transmitting data along with the broadcast data, paragraph 72, lines 1-5) with non-on-demand media data (figs. 3H and 3I, and paragraphs 95, 96, and 97).

At the time of invention, it would have been obvious to one skilled in the art to add the metadata of Lewis, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more opportunities to customize the media program being watched.

As regards Claims 12, 32, 52, and 72, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose providing metadata contemporaneously with on-demand media data.

Lewis discloses providing metadata (such as embedded control data that allows a user to edit or remove certain sections of the media) contemporaneously (such as by transmitting data along with the broadcast data, paragraph 72, lines 1-5) with on-demand media data (figs. 3H and 3I, and paragraphs 95, 96, and 97).

At the time of invention, it would have been obvious to one skilled in the art to add the metadata of Lewis, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to give the user more opportunities to customize the media program being watched.

12. Claims 14-15, 34-35, 54-55, and 74-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Aristides (US 5,630,119)**.

As regards Claims 14, 34, 54, and 74, Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose determining if the on-demand media data is cached.

Aristides discloses determining if the on-demand media data is cached (such as program info in a program guide, col. 6, lines 27-32).

At the time of invention, it would have been obvious to one skilled in the art to add the caching of Aristides, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to provide a smoother experience to the user.

As regards Claims 15, 35, 55, and 75, Shah-Nazaroff discloses the method and computer readable medium of Claims 1, 21, 41, and 61 but fails to disclose determining

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if the on-demand media data needs to be retrieved from the on-demand media data source. Aristides discloses determining if the on-demand media data needs to be retrieved from the on-demand media data source (such as from the program guide head-end, col. 6, lines 32-39).

At the time of invention, it would have been obvious to one skilled in the art to add the caching of Aristides, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to provide a smoother experience to the user.

13. Claims 16, 36 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Rosin (US 6,028,600)**.

As regards Claims 16, 36 and 56 Shah-Nazaroff discloses the method, computer readable medium, and system of Claims 1, 21, 41, and 61 but fails to disclose determining whether a connection exists between the interactive television application system and the on-demand media data source.

Rosin discloses determining whether a connection exists between the interactive television application system and the on- demand media data source (Abstract, fig. 12, and col. 15, lines 43-47).

At the time of invention, it would have been obvious to one skilled in the art to add the determination of a connection of Rosin, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to insure that a connection exists before any attempt at retrieving the on-demand media is made.

14. Claim 77 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Shah-Nazaroff et al (6,157,377)** in view of **Hooper (US 5,414,455)**.

As regards Claim 77, Shah-Nazaroff discloses the method, computer readable medium, and system of Claim 61, but fails to disclose establishing a connection between the interactive television application system and the on-demand media data source.

Hooper discloses establishing a connection between the interactive television application system and the on-demand media data source (Abstract, fig. 12, and col. 15, lines 43-47).

At the time of invention, it would have been obvious to one skilled in the art to add the establishing of a connection of Hooper, an analogous art, to the non-on-demand and on-demand audio-video delivery of Shah-Nazaroff to insure that a connection exists before any attempt at retrieving the on-demand media is made..

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative or access** to the automated information system, **call 800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

/Annan Q Shang/
Primary Examiner, Art Unit 2424

Annan Q. Shang